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In re Application of:	:	
LAURITZEN, Nels, J., et al.	:	DECISION ON REQUEST UNDER
U.S. Application No.: 10/580,904	:	37 CFR 1.497(d)
PCT No.: PCT/US2004/040034	:	
International Filing Date: 29 November 2004	:	
Priority Date: 28 November 2003	:	
Attorney's Docket No.: 13627PCTUS	:	
For: COMPOSITIONS AND METHODS	:	
COMPRISING COLLAGEN	:	

This decision is issued in response to the "Response To Notification Of Defective Response" filed 04 September 2008, treated herein as a request to correct inventorship under 37 CFR 1.497(d). Pursuant to the authorization to charge required fees included in the Form PTO-1390 Transmittal Letter filed 26 May 2006, Deposit Account No. 11-0171 will be charged the required \$130 processing fee.

### BACKGROUND

On 29 November 2004, applicants filed international application PCT/US2004/040034. The application claimed a priority date of 28 November 2003, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 28 May 2006. The published international application identified two applicant/inventors for the U.S.: Nels J. LAURITZEN and Joseph NICHOLS.

On 26 May 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the small entity basic national fee.

On 18 June 2008, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the \$65 small entity surcharge for filing the oath or declaration later than thirty months after the priority date.

On 29 July 2008, applicants filed a response to the Notification Of Missing Requirements that included payment of the required surcharge and a declaration that names and is executed by only one of the two inventors of record, Nels J. LAURITZEN.

On 04 August 2008, the DO/EO/US mailed a "Notification Of Defective Response" (Form PCT/RO/EO/916) indicating that the declaration filed 29 July 2008 was not acceptable based on the failure to include inventor of record Joseph NICHOLS.

On 04 September 2008, applicants filed the "Response To Notification Of Defective Response" considered herein as a request to correct inventorship under 37 CFR 1.497(d). The submission indicates that Joseph NICHOLS was incorrectly identified as an inventor on this application and requests that this inventor be deleted as an inventor of record.

### DISCUSSION

Section 1893.01(c) of the MPEP states the following regarding changes in the inventorship of an international application entering the national stage (emphasis added):

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92*bis*. See 37 CFR 1.41(a)(4). Accordingly, **an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied.** These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

As noted above, applicants have filed a declaration that names an inventive entity different than that set forth in the international application (specifically, Joseph NICHOLS has been deleted). Accordingly, applicants must satisfy the requirements of 37 CFR 1.497(d) before such declaration can be accepted.

The present submission includes the required statement of non-deceptive intent from the person to be deleted as an inventor (Joseph NICHOLS), and applicants have previously authorized a charge to Deposit Account No. 11-0171 for required fees, pursuant to which the required processing fee will be charged. Thus, requirements (A) and (B) are satisfied. However, applicants have not submitted the written consent of the assignee to the requested change in inventorship, or a statement confirming that no such assignee exists. Requirement (C) is therefore not satisfied.<sup>1</sup>

Based on the above, applicants have failed to submit all the requirements of a grantable request under 37 CFR 1.497(d). Accordingly, the request to delete Joseph NICHOLS as an inventor of record herein is appropriately dismissed on the present record.

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<sup>1</sup> It is noted that such assignee consent must be submitted in compliance with 37 CFR 3.73(b).

**CONCLUSION**

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The inventorship of record herein remains that set forth in the international application, that is, Nels J. LAURITZEN and Joseph NICHOLS.

The declaration filed 29 July 2008, which does not include Joseph NICHOLS, remains defective on the present record for failure to be executed by, and properly identify, all the inventors of record herein.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Request Under 37 CFR 1.497(d)" and must include the materials required to satisfy item (C) of a grantable petition, as discussed above and in the MPEP, that is, the written consent of the assignee to the proposed change of inventorship in the form required by 37 CFR 3.73(b) (or, if there is no assignee, an express statement confirming that no assignee exists).

Failure to file a proper and timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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